73. The method of claim 68, wherein the cross-linking agent is selected from the group consisting of formaldehyde and glutaraldehyde.

74. The method of claim 68, wherein the cross-linking agent comprises about 1% to about 5% of the medium.

REMARKS

The newly added claims find support in the application and claims as originally filed and, in particular, in the claims cancelled herewith. The recitation of "alcohol" in claims 36, 55, and 58 finds support in the application at page 8, second and third full paragraphs. The recitations of "an aldehyde comprising between about 1% and about 10% of the medium" and "an aldehyde comprising between about 1% and about 5% of the medium" found in claims 37, 38, 56, 57, 59, 61, and 74 find support in the specification at page 9, first full paragraph. No new matter is introduced by the new claims and entry thereof is respectfully requested.

Response to Double Patenting Rejection

Claims 1-11 and 15-27 and 29-35 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-11 and 16-28 of copending application Serial No. 09/598,571. Applicants agree to file a terminal disclaimer upon issuance of claims in this application. The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). Applicants respectfully request reconsideration and withdrawal of this ground of rejection.

Response to Section 102 Rejection

Claims 1-4 were rejected under 35 U.S.C. § 102(e) for being anticipated by Dunphy U.S. Patent No. 5,679,333. The Examiner contends that "Dunphy teaches a medium containing a preservative an antidegradation agent and a cross-linking agent wherein the cross-linking agent is an aldehyde (i.e. ethanedial) comprising 14% v/v (col. 7, lines 1-10)." Applicants respectfully disagree with this ground of rejection. The solution referred to by the Examiner is described by Dunphy as a "pre-injection (co-injection) composition." Column 6, lines 63-65. Dunphy reports that "[t]he major role of the pre-injection fluid is to clear clots and other obstructions from the circulatory system (primarily the vascular system), although the pre-injection fluid can have some tissue preservation and disinfection properties." Column 2, lines 57-61. In fact, the pre-injection fluid contains a protease enzyme. This is the opposite of applicants' claims which describe a medium that contains an anti-degradation agent. Nowhere does Dunphy teach a medium enabling direct cytological and molecular analysis comprising a preservative, an anti-degradation agent and an aldehyde cross-linking agent comprising about 1% to about 15% of the medium. However, in the interest of moving forward with the prosecution of this application, applicants present new claims that describe a medium comprising a preservative, an anti-degradation agent and an aldehyde cross-linking agent comprising about 1% to about 10% of the medium and claims that describe a medium comprising an alcohol, an anti-degradation agent and an aldehyde cross-linking agent comprising about 1% to about 15% of the medium. Therefore, applicants respectfully request reconsideration and withdrawal of this ground of rejection.

Response to Section 103 Rejection

Claims 5-11, 15-20, 24-27, and 33-35 were rejected under 35 U.S.C. § 103(a) for being unpatentable over Dunphy U.S. Patent No. 5,679,333 in view of Hurley U.S. Patent No. 5,256,571. The Examiner contends that Dunphy discloses a cell preservation fluid containing 3.75% of a cross-linking agent and that Hurley describes a solution containing an alcohol, a buffer and EDTA. The Examiner contends that it would have been obvious to modify the solution of Dunphy by combining it with Hurley. Applicants respectfully disagree with this ground of rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991).

The combination of Dunphy and Hurley fails to teach or suggest all the claim limitations. Dunphy states that its solution is "designed for use in preserving tissue samples for histological study and evaluation." Column 7, lines 60-63. Hurley states that its solution "enhances maintenance of the nuclear structures of the cells, in that it maintains cell membranes intact for subsequent cytological staining." Column 3, lines 4-9. There is no teaching or suggestion in the combination of cited art of a medium that enables direct analysis of cells by both cytological and molecular methods of analysis. Applicants' declaration, filed March 14,

2001 in co-pending application Serial No. 09/598,571 (copy enclosed), shows that not all solutions reported in the cited art enable direct analysis of cells by molecular methods. Therefore, applicants respectfully request reconsideration and withdrawal of this ground of rejection.

Claims 13, 14, 29, 30, and 32 were rejected under 35 U.S.C. § 103(a) for being unpatentable over Dunphy U.S. Patent No. 5,679,333, in view of Hurley U.S. Patent No. 5,256,571, and further in view of Harrison U.S. Patent No. 4,578,282. The Examiner contends that Harrison discloses a fixative composition for histological or cytological preparations containing a C1-C10 alcohol and water wherein glutaraldehyde is added for a greater degree of complexing fixation. Applicants respectfully disagree with this rejection. Harrison does not even describe a collection medium. Harrison describes "a fixative which is preapplied to a slide or other test surface and which presents a substantially dry, non-fluid surface to which the sample is applied." Column 1, lines 41-45. Thus, combining Harrison with Dunphy and Hurley is improper as there is no motivation to combine these references. Further, the combination fails to teach or suggest all the claim limitations. There is no teaching or suggestion in the combination of cited art of a medium that enables direct analysis of cells by both cytological and molecular methods of analysis. Therefore, applicants request reconsideration and withdrawal of this ground of rejection.

Claims 21-23, 28, and 31 were rejected under 35 U.S.C. § 103(a) for being unpatentable over Dunphy U.S. Patent No. 5,679,333, in view of Hurley U.S. Patent No. 5,256,571, further in view of Harrison U.S. Patent No. 4,578,282, and further in view of Wainwright U.S. Patent No. 5,370,128. The Examiner contends that Wainwright discloses an article of manufacture comprising a container, a lid fitting the container and a brush for

preserving a cell sample. Applicants respectfully disagree with this ground of rejection. The combination of cited art fails to teach or suggest all the claim limitations. Therefore, applicants respectfully request reconsideration and withdrawal of this ground of rejection.

AUTHORIZATION

No additional fee is believed necessary. However, the Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 2629-4005US1.

Respectfully submitted,

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